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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/804,074	Applicant(s) JOHNSON ET AL.	
	Examiner Mohammad A Siddiqi	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/26/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-58 are presented for examination.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Eintracht et al. (96,687,878) (hereinafter Eintracht).

3. As per claims 1 and 23, Eintracht discloses a computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps (see abstract, col 2, lines 8-67, col 3, lines 1-67) of:

generating a collaborative content including a base document and at least one collaborative content element (col 2, lines 40-46);

rendering said collaborative content (col 2, lines 8-55); and

transmitting said collaborative content between client workstations.  
(col 2, lines 8-67).

4. As per claims 2 and 24, Eintracht discloses further comprising the steps of: annotating said collaborative content by adding another collaborative content element (col 2, lines 34-67).

5. As per claims 3 and 25, Eintracht discloses wherein said annotating step comprises presenting annotation options to said client workstation (col 2, lines 34-67).

6. As per claims 4 and 26, Eintracht discloses wherein said annotating step comprises inputting a text element to name said collaborative content element (col 15, lines 10-14).

7. As per claims 5 and 27, Eintracht discloses wherein said annotating steps comprises inputting a text input element to generate text as said collaborative element (col 15, lines 10-20).

8. As per claims 6 and 28, Eintracht discloses wherein said annotating steps comprises providing a visual cue to indicate the state of said collaborative content composition step (col 2, lines 65-67).

9. As per claims 7 and 29, Eintracht discloses wherein said visual cue comprises at least one of a marker, cursor, icon, and marquee box (col 7, lines 1-17).

10. As per claims 8 and 30, Eintracht discloses wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content (col 2, lines 47-67, col 3, lines 1-4).

11. As per claims 9 and 31, Eintracht discloses wherein said client workstation includes at least one of a personal computer equipped with internet browser software, a mobile communication device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer (col 2, lines 34-40).

12. As per claims 10 and 32, Eintracht discloses wherein said client workstation includes a program execution capability comprising: an interpreted software program (Java, col 9, lines 26-32);

a compiled software program (Java, col 9, lines 26-32);  
and a software program executed by a virtual machine (Java, col 9, lines 26-32).

13. As per claims 11 and 33, Eintracht discloses wherein said transmitting step is performed using a messaging system (fig 3, col 7, lines 24-52).

14. As per claims 12 and 34, Eintracht discloses wherein said messaging system includes at least one of:

an electronic mail system (fig 3, col 7, lines 24-52); an  
electronic news or bulletin-board system (members of the group, col 1, lines 26-36);  
and a mobile paging system (messaging system, fig 3, col 7, lines 24-52).

15. As per claims 13 and 35, Eintracht discloses wherein said transmitting step is performed using a transport mechanism including at least one of:

an internet protocol (col 9, lines 24-60, col 10, lines 28-39);  
a wireless protocol (URL, col 9, lines 24-60, col 10, lines 28-39);  
a synchronous messaging protocol (URL, col 9, lines 24-60, col 10, lines 28-39, col 2, lines 9-67); and

an asynchronous messaging protocol (URL, col 9, lines 24-60, col 10, lines 28-39, col 2, lines 9-67).

16. As per claims 14 and 36, Eintracht discloses wherein said rendering step is performed on a client workstation (col 2, lines 16-67).

15. As per claims 15 and 37, Eintracht discloses wherein said rendering step is performed on a server (col 2, lines 56-67).

17. As per claims 16 and 38, Eintracht discloses wherein the collaborative content transmitted in said transmitting step includes a URL and rendering instructions (col 4, lines 53-58).

18. As per claim 17, Eintracht discloses a network collaboration tool using embedded annotation and rendering instructions comprising:

a web browser software for displaying collaborative content (col 2, lines 9-67, col 7, lines 24-44);

a graphical collaboration tool for generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element (fig 2-3, col 2, lines 9-67, col 7, lines 24-44);

and a server process for receiving at least one generated collaborative content elements, rendering the collaborative content in combination with the collaborative content elements, and generating a combined collaborative content including collaborative content elements for display by said web browser software (fig 2-3, col 2, lines 9-67, col 7, lines 24-44).

19. As per claim 18, Eintracht discloses wherein said graphical collaboration tool includes a toolbar (col 7, lines 24-44).

20. As per claim 19, Eintracht discloses wherein said toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (col 7, lines 24-44, col 17, lines 45-55).

21. As per claim 20, Eintracht discloses wherein said graphical collaboration tool includes a collaborative content element name entry field (col 7, lines 24-44, col 17, lines 18-67).

22. As per claim 21, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system (col 7, lines 24-35).



23. As per claim 22, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (fig 2-3, col 7, lines 24 –51).

24. As per claim 39, Eintracht discloses wherein said sequences of instructions include at least one of a client-side scripting language (page description language, col 6, lines 31–54).

25. As per claim 40, Eintracht discloses wherein said sequences of instructions include at least one of Javascript and dynamic HTML (page description language, col 6, lines 31-54, col, col 9, line 28-30).

26. As per claim 41, Eintracht discloses a client system for network collaboration comprising:

- a collaborative content (see abstract); and
- a graphical collaboration tool for generating (fig 3, col 6, lines 31-54), transmitting (col 2, lines 8-55), and rendering said collaborative content (col 2, lines 8-55) wherein said graphical collaboration tool is downloaded from a server (plug-in, fig 3, col 7, lines 24–43).

27. As per claim 42, Eintracht discloses wherein said collaborative content is referencable by a URL (col 4, lines 13-37).

28. As per claim 43, Eintracht discloses wherein said graphical collaboration tool includes a client-side scripting language (page description language, col 6, lines 31-54).

29. As per claim 44, Eintracht discloses wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML (page description language, col 6, lines 31-54).

30. As per claim 45, Eintracht discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (fig 5, col 4, lines 13-38).

31. As per claim 46, Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said

collaborative content including the added collaborative content element (see abstract, fig 5, col, lines 31-54).

32. As per claim 47, Eintracht discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to modify a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element (see abstract, fig 5, col 6, lines 31-54).

33. As per claim 48, Eintracht discloses wherein said graphical collaboration tool includes a toolbar (Graphical user interface, col 6, lines 31-54).

34. As per claim 49, Eintracht discloses wherein the toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (col 17, lines 45-64).

35. As per claim 50, Eintracht discloses wherein the toolbar includes a collaborative content element name entry field (col 17, lines 17-19).

36. As per claim 51, Eintracht discloses wherein said collaborative content received from the server includes an HTML page (col 6, lines 31-54, col 5, line 40).

37. As per claim 52, Eintracht discloses wherein said collaborative content received from the server includes an HTML page (col 6, lines 31-54, col 5, line 40).

38. As per claim 53, Eintracht discloses a server system for network collaboration comprising:

a collaborative content (see abstract); and

a server process for responding to a user request wherein the user request includes at least one of a request for said collaborative content (col 2, lines 8-67, col 3, lines 12-36), a graphical collaboration tool (fig 3, col 6, lines 31-54), said collaborative content including an added collaborative content element (col 2, lines 8-67), and said collaborative content including a modified collaborative content element (abstract, col 3, lines 5-67).

39. As per claim 54, Eintracht discloses wherein said collaborative content is referencable by a URL (col 4, lines 13-37).

40. As per claim 55, Eintracht discloses wherein said server process is a CGI script (col 30, lines 31-54).

41. As per claim 56, Eintracht discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (col 4, lines 13-37).

42. As per claim 57, Eintracht discloses wherein said server process executes on a client workstation of a user (col 2, lines 34-67).

43. As per claim 58, Eintracht discloses wherein said collaborative content transmitted in response to a user request includes an HTML page (col 6, lines 31-54, col 5, line 40).

### ***Response to Arguments***

44. Applicant's arguments filed 10/26/2004 have been fully considered but they are not persuasive, therefore, the rejections to claims 1-58 is maintained.

45. In response to applicants argument "teaches away" on page 13 (line 21) is improper because the rejection is by anticipation, not by obviousness.

46. In response to the argument "Eintracht either teach or suggest collaboration through embedded annotation" on page 13 (line 3). Even though preamble recites "embedded annotation" but none of the element in the body of the claim indicates "embedded annotation".

47. Applicants argued in the remarks:

A. Claims 1 and 23, "Eintracht does not teaching generating a collaborative content including a base document".

B. Claims 2 and 24, "Eintracht no where teach annotating said collaborative content"

C. Claims 4 and 26, "Eintracht teach or even suggest inputting text"

D. Claims 6 and 28, "Eintracht teach or even suggest providing a visual cue"

E. Claims 8 and 30, "Eintracht teach or even suggest providing a user selecting".

F. Claims 15 and 37, "Eintracht teach or even suggest a rendering step".

G. Claims 16 and 38, "Eintracht teach or even suggest the collaborative content".

H. Claim 17, "Eintracht does not anticipate independent claim 17".

I. Claims 21, "Nowhere does Eintracht teach or suggest web browser".

J. Claim 22, "Nowhere in the cited"

K. Claim 39, "Nowhere does Eintracht teach a memory coupled to the processor".

L. Claim 40, "Nowhere does Eintracht teach a memory coupled with processor"

M. Claim 41, "Eintracht does not teach a collaborative content".

N. Claim 42, "Eintracht does not teach a collaborative content".

O. Claim 45, "Eintracht does not teach collaborative content"

P. Claim 46, "Eintracht does not teach collaborative content".

Q. Claim 53, "Eintracht teach or suggest or even hint at a server system".

R. Claim 57, "Nowhere either at the cited location in the reference".

48. In response to argument A, Eintracht discloses a computer-implemented method of network collaboration through embedded annotation (associated with a specific location in a document, col 7, lines 55-57) and rendering instructions to generate (creating, col 3 line 23), transmit, and render collaborative content (transmits, col 2, lines 41-46), the method comprising the steps (col 2, lines 8-67, col 3, lines 1-67) of: generating (creating, col 3 line 23) a collaborative content (collaborative document, col 1, lines 8-13) including a base document (annotations related to the specific document, col 2, lines 22- -24) and at least one collaborative content element (col 2, lines 40-46); rendering (58,fig 3, col 5, lines 60-66, col 7, lines 55-57 graphical drawing), lines said collaborative content (col 2, lines 8-55); and transmitting (transmits col 2, lines 41-46) said collaborative content(collaborative document, col 1, lines 8-13) between client (client, col 2, lines 41-46) workstations (workstation, col 1, lines 8-10 and lines col 2, lines 8-67).

49. In response to argument B, Eintracht discloses annotating said collaborative content by adding (new notes, col 2, lines 44-46) another collaborative content element (edit, create, col 2, lines 34-67).



50. In response to argument C, Eintracht discloses annotating step comprises inputting a text element to name said collaborative content element (user can enter text and note anchor, col 15, lines 10-16).

51. In response to argument D, Eintracht discloses providing a visual cue to indicate the state (trigger and change being made, col 2, lines 62-67) of said collaborative content composition step (visual indication, col 2, lines 65-67).

52. In response to argument E, Eintracht discloses initiated by a user selecting (permitting multiple clients to annotate, col 2, lines 56-58) a visual element to transmit said collaborative content (visual indication, col 2, lines 47-67, col 3, lines 1-4).

15. In response to argument F, Eintracht discloses rendering step is performed on a server (Notes server, col 8, lines 34-39 and col 2, lines 56-67).

53. In response to argument G, Eintracht discloses collaborative content transmitted in said transmitting step includes a URL and rendering instructions (URL, col 4, lines 13-20).

54. In response to argument H, Eintracht discloses a network collaboration tool (software, col 2, lines 16-18) using embedded annotation (associated with a specific location in a document, col 7, lines 55-57) and rendering instructions comprising: a web browser software (web browser window, col 2, lines 47-48) for displaying collaborative content (col 2, lines 9-67, col 7, lines 24-44); a graphical collaboration tool (software, col 2, lines 16-18) for generating at least one collaborative content element ( Collaborative document, col 1, lines 8-10) on the collaborative content displayed in said web browser software (web browser window, col 2, lines 47-48) and transmitting the at least one collaborative content element (fig 2-3, col 2, lines 9-67, col 7, lines 24-44); and a server process for receiving at least one generated collaborative content elements (transmits, col 2, line s42-46), rendering the collaborative content in combination with the collaborative content elements, and generating a combined collaborative content including collaborative content elements for display by said web browser software (web browser window, col 2, lines 9-67, col 7, lines 24-44).

55. In response to argument I, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same (no clear description in specification of same) computer

system (same system requirements for example standard browser, HTTP, col 7, lines 24-35).

56. In response to argument J, Eintracht discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (elements, fig 2, col 7, lines 24 -51).

57. In response to argument J, Eintracht discloses sequences of instructions include at least one of a client-side scripting language (page description language, col 6, lines 31—54).

58. In response to argument K and L, Eintracht discloses Memory coupled with processor (process running on the web server computer, col 9, 49-50 and col 5, lines 30-35).

59. In response to argument M-R, these arguments are repetitive in nature and have been answered in paragraph 49-59, above.

60. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

61. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

### ***Conclusion***

62. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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